

REMARKS

Claims 62, 65, 68, 70, 73, 75-77, 81, 84, 86-90 and 92-95 are pending in this application, with Claims 62, 68, 75, 81, 87, 88, 92 and 93 amended, and Claims 1-61, 63, 64, 66, 67, 69, 71, 72, 74, 78-80, 82, 83, 85 and 91 cancelled. The Applicant respectfully requests reconsideration and review of the application in view of the amendments and the following remarks.

At the outset, the Applicant is requesting a telephonic interview with the Examiner prior to the issuance of a first Office Action. In light of the Decision on Appeal ("Decision") , issued on April 6, 2012, Applicant believes that such an interview would be helpful to resolve issues raised by the Board of Appeals and Interferences ("BPAI") in their Decision. As discussed below, the claims have been amended in light of the Decision, and Applicant believes that such an interview would advance prosecution of the present application, and expedite a timely Notice of Allowance.

Before addressing the merits of the rejections based on prior art, the Applicant provides the following brief description of the present application. The present invention is directed toward a system and method for adding an advertisement to a personal communication. Specifically, as shown in Figures 1 and 2, the system (10) comprises a Web site (110) and a plurality of network devices (120, 130), wherein the Web site (110) is in communication with the plurality of network devices (120, 130) via a wide area network (102) (e.g., the Internet), and comprises a server (112), an advertising application (114) and a memory device (116). In one embodiment of the present invention, the advertising application (114) is configured to (i) automatically select an advertisement from a plurality of advertisements (e.g., as stored in the memory device), (ii) insert the advertisement into an email, and (iii) send the email to at least one of the plurality of network devices.

In another embodiment of the present invention, the advertising application is further configured to ***use at least a portion of the content or subject matter of the email to select an advertisement from a plurality of advertisements.*** Such a system is advantageous over the prior art in that it provides advertisements for products

to consumers that are more likely to be interested in the products. The system does this by inserting advertisements into emails that include related subject matter and/or content. For example, an advertisement for Nike™ may be inserted into an email concerning sports (e.g., an email asking a recipient whether he/she would like to go to a football game).

In yet another embodiment of the present invention, a user of the system is allowed to customize (or create) a pallet of acceptable advertisements. By way of example, an advertising application may be configured to ***allow a user to remove (or insert) at least one advertisement from (or into) a pallet of acceptable advertisements***, and ***use at least a portion of the content or subject matter of the email to select an advertisement from the pallet of acceptable advertisements***. Such a system is advantageous over the prior art in that it provides advertisements for products to consumers that are more likely to be interested in the products. The system does this, for example, by not inserting advertisements into emails that a user of the system finds offensive, unacceptable, not applicable, etc. For example, if a user of the system is a Hindu, then the user may decide to block advertisements for McDonalds™, or other distributors of beef byproducts.

In the Office Action dated August 10 2009, the Examiner rejected Claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90 and 92-95 under 35 U.S.C. § 103(a) for being unpatentable over Gabbard et al. (U.S. Pat. No. 6,205,432) ("Gabbard") in view of Roth et al. (U.S. Pat. No. 6,285,987) ("Roth"). In response, the Applicant filed an appeal with the BPAI, appealing the Examiner's rejections of the pending claims. On April 6, 2012, the Board issued its Decision, affirming the Examiner's rejections.

While the Applicant disagrees with the Board's Decision, of particular interest, is the Board's discussion of ***dependent Claims 88 and 93***. See Decision on Appeal at pp. 8-9. Claim 88, which (at the time of appeal) depended from Claim 87, further provided the steps of "allowing a sender to select a type of advertisement that can be included in said personal communication by submitting advertisement-type data, said sender-provided data further comprising said advertisement-type data; and using said at least a

portion of said communication data and said advertisement-type data to select said at least one of said plurality of advertisements.” Claim 93, which depended from Claim 92, included similar limitations. In affirming the rejections of Claims 88 and 93, the Board found the terms “sender” and “advertisement-type data,” given their broadest reasonable construction, were disclosed in Gabbard.

In light of the Board’s decision, and in an effort to expedite a timely Notice of Allowance, the Applicant has amended Claim 62 to clarify the “advertisement-type data” feature, and how advertisement-type data can be used to select an advertisement to be included in an email. In particular, Claim 62 has been amended to provide that the advertising application functions by “providing at least a portion of said plurality of advertisements to one of said plurality of network devices, said plurality of advertisements including a first advertisement, ***receiving a remove command from said one of said plurality of network devices, said command being used by said advertising application to remove said first advertisement from said plurality of advertisements, thereby creating a pallet of advertisements, ... and using at least a portion of the content of said communication data to automatically select at least one advertisement from said pallet of advertisements.***”

In other words, Claim 62 has been amended to provide that a user of the system can submit a command to remove an undesirable advertisement from the plurality of advertisements, thereby creating a pallet of acceptable advertisements. The pallet of acceptable advertisements is then used in selecting an advertisement that is inserted into an email, wherein the selection is based (at least in part) on content (or subject matter) of the email. This feature is not disclosed in or suggested by either Gabbard or Roth. Thus, the rejection of independent Claim 62, and the rejections of independent Claims 68, 75, 81, 87 and 92, which include similar limitations, should be withdrawn. Further, the rejections of Claims 65, 70, 73, 76, 77, 84, 86, 88-90 and 93-95, which depend from the foregoing independent claims, should also be withdrawn.

The Applicant respectfully submits that Claims 62, 65, 68, 70, 73, 75-77, 81, 84, 86-90 and 92-95 are in condition for allowance. Reconsideration and withdrawal of the

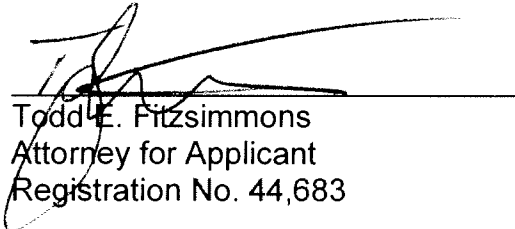
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rejections is respectfully requested, and a timely Notice of Allowability is solicited. As discussed above, the Applicant respectfully requests a telephonic interview prior to the issuance of a first Office Action. It is therefore requested that the Examiner contact the undersigned Counsel at (213) 430-7522 and suggest a date and time for such an interview.

The Commissioner is authorized to charge \$465 pursuant to 37 C.F.R. §1.17(e) for the filing of an RCE, and any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0639.

Respectfully submitted,

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